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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,516	01/07/2002	Shuji Otsuka	011784	5125

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EXAMINER

ZEWDU, MELESS NMN

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/036,516	<b>Applicant(s)</b> OTSUKA ET AL.	
	<b>Examiner</b> Meless N Zewdu	<b>Art Unit</b> 2683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-14 is/are allowed.
- 6) ☒ Claim(s) 1-8, 15-27 and 29-32 is/are rejected.
- 7) ☒ Claim(s) 9, 28 and 33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

**DETAILED ACTION**

***Response to Amendment***

1. This action is in response to the communication filed on 12/21/05.
2. Claims 1-33 are pending in this action.

***Allowable Subject Matter***

The indicated allowability of claims 1-14 and 17-33 is withdrawn in view of the newly discovered reference(s) as shown below. Rejections based on the newly cited reference(s) follow.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-16, 18, 20, 22, 1, 3-8 and 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johansson et al. (Johansson) (US 6,442,391 B1) in view of Ahya et al. (Ahya) (US 6,600,928 B1).

**As per claim 15:** a portable communications device capable of transmitting by radio communication position information representing the position of the device to one or a

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plurality of terminal communication units via a position information providing device (see col. 1, lines 27-35; col. 12, lines 17-23), comprising:

checking whether it is approved to provide the position information for said one or plurality of terminal communications units in response to an information input

manipulation by a user reads on '391 (col. 2, line 23-col. 3, line 35). One terminal unit can constitute a list. But, Johansson does not explicitly teach about means for preparing a list and transmitting means for converting data as to the prepared list to a radio signal and transmitting the radio signal, as claimed by applicant. However, in a related field of endeavor, Ahya teaches about a establishing a temporary call group in a wireless communication system wherein a user prepares a list of call group members and transmit the list to the wireless infrastructure (see col. 3, lines 45-58). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of Johansson with that of Ahya for the advantage of preparing and transmitting to a network a list of mobile station identifiers a user wants to include in the list. Although examiner is aware that Ahya's reference is directed to a group talk system, compiling/preparing the list of mobile station identifiers and transmitting this list, via radio communication, to a network is the relevant aspect of teaching one of ordinary skill in the art can use to modify the Johansson reference.

**As per claim 16:** some of the features of claim 16 are similar to the features of claim 15. Hence, the similar features of claim 16 are rejected on the same ground and motivation as claim 15. The difference features are provided as shown below.

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means for receiving position data from a plurality of position reference stations arranged on a satellite and/or the ground reads on '391 (see col. 1, lines 27-35; col. 12, lines 17-23), comprising:

control means for discontinuing the information measuring operation of the position measuring means in response to a position measurement discontinuing manipulation by the user reads on '391 (see col. 2; line 23-col. 3, line 11).

**As per claim 18:** some of the features of claim 18 are similar to the features of claims 15 and 16. Hence, similar features of claim 18 are rejected on the same ground and motivation as claims 15 and 16. the difference features of claim 18 are provided as shown below.

position information providing device capable of receiving from a portable communications device position information representing the position of the portable device and transmitting the position information to one or a plurality of terminal communications units reads on '391 (see col. 4, lines 65; col. 5, line 66-col. 6, line 26), the position information providing device comprising:

means for receiving list data transmitted from the portable communications device reads on '928 (see col. 3, lines 10-14);

list register means for registering the list data reads on '928 (see col. 3, lines 10-14). The DAP listing the transmitted list must have a list register. Furthermore, when the references are modified as shown above, the list can be stored in the register provided by Johansson 391 (see col. 3, lines 12-21;

information processing means for registering the received list data in the list register means reads on '928 (see col. 3, lines 10-14). The DAP which is not excluded by the claims includes processing means. Furthermore, when the references are combined as shown above, the list can be stored in the register provided by Johansson 391' (see col. 2, line 23-col. 3, line 35).

**As per claim 20:** the features of claim 20 are similar to the features of claim 15. Hence, claim 20 is rejected on the same ground and motivation as claim 15.

**As per claim 22:** the features of claim 22 are similar to the features of claim 18. Hence, claim 22 is rejected on the same ground and motivation as claim 18. A slight differential feature of claim 22 is directed to a means for preparing a list data which was shown in the rejection of claim 18 that a mobile device is capable of creating/preparing a list data which is transmitted to the DAP.

**As per claim 1:** the features of claim 1 are similar to the features of claims 15 and 18. Hence, claim 1 is rejected on the same ground and motivations as claims 15 and 18.

**As per claim 3:** the features of claim 3 are similar to the features of claims 15 and 18. Hence, claim 3 is rejected on the same ground and motivation as claims 15 and 18.

**As per claim 4:** a position information providing system according to claim 3, wherein the list comprises information for identifying only one or a plurality of terminal communications units reads on '928 (see col. 3, lines 45-58). When the references are combined as shown above, the system will include means/method of identifying terminal units of which provision of position information is not approved, and the checking means of the position information providing device checks whether provision of the position

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information for the terminal unit is approved based on whether the terminal unit identifying information is included in the list data.

**As per claim 5:** a position information providing system according to claim 3 wherein when provision of the position information is not found approved, the transmitting means of the position information providing device transmits notification information to this effect to the terminal unit reads on '391 (see col. 3, lines 1-35). It is obvious that if the mobile doesn't want his/her where-about to disclosed the party seeking the where about of the mobile will be denied from having the location information. In this case, the act of denying obviously includes notifying the location requester that location information is denied.

**As per claim 6:** the feature of claim 6 is similar to the feature of claim 15. Hence, claim 5 is rejected on the same ground and motivation as claim 15.

**As per claim 7:** a position information providing system according to claim 3, wherein the portable communications device comprises time setting means for setting a list transmitting time input by the user, and time detecting means for detecting arrival of the list transmitting time set by the time setting means, and the transmitting means of the portable communication device transmits the data as to the prepared list to the position information providing device upon the time detecting means detecting the arrival of the list transmitting time reads on '928 (see col. 3, line 45-col. 4, line 3). The list is updated based on a predetermined time set by the user.

**As per claim 8:** a position information providing system according to claim 3, wherein the transmitting means of the portable communications device transmits a list

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invalidation command signal as converted to a radio signal to the position information providing device in response to a list invalidating manipulation by the user, and the position information providing means comprises invalidation processing means for invalidating registration of the list data in the list register means upon the receiving means thereof receiving the list invalidation command signal reads on '928 (see col. 3, line 45-col. 4, line 3). Examiner believes that if a mobile unit is capable of preparing and transmitting a list to a network entity, it would have been obvious that it also can send a signal/command to that entity to remove/delete the list it sent.

**As per claim 23:** the feature of claim 23 is similar to the feature of claim 4. Hence, claim 23 is rejected on the same ground and motivation as claim 4.

**As per claim 24:** the feature of claim 24 is similar to the feature of claim 5. Hence, claim 24 is rejected on the same ground and motivation as claim 5.

**As per claim 25:** the feature of claim 25 is similar to the feature of claim 6. Hence, claim 25 is rejected on the same ground and motivation as claim 6. Furthermore, a list accepted, as shown above, can be considered as validated.

**As per claim 26:** the features of claim 26 are similar to the features of claim 8. Hence, claim 26 is rejected on the same ground and motivation as claim 8.

**As per claim 27:** the features of claim 27 are similar to the features of claim 6. In that, a list created and transmitted by a user and accepted a network entity can be invalidated/deleted by the same user.



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Claims 2, 17, 19, 21 and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johansson in views of Ahya and Furlong et al. (Furlong) (US 2003/0028621 A1).

**As per claim 17:** some of the features of claim 17 are similar to the features of claim 16. Hence, the similar features of claim 17 are rejected on the same ground and motivation as claim 16. The difference features of claim 17 are provided as shown below. With regard to claim 17, Johansson in view of Fuchs do not explicitly teach about time setting means for setting a position measurement discontinuing time input by a user and time detecting means for detecting arrival of the position measurement discontinuing time set by the time setting mean, as claimed by applicant. However, in a related field of endeavor, Furlong teaches about presence, location and availability communication system and method, wherein a subscriber is provided with a means to control access to the subscriber by applying availability rules in a preference engine when access request for that subscriber is arrived, wherein the preference rules include, among other features, day of week and/or time of day (see page 3, paragraphs 0029-0038). According to this reference, the time is input/set by the user; a request for the mobile user can be can be denied or accepted based on the preference rule. The location of the mobile user and time of availability are related (see page 1, paragraph 0007-page 2, paragraph 0012). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the above references with the teaching of Furlong for the advantage of service providers to

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manage presence, location and availability (see page 1, paragraph 0004, 0011-page 2, paragraph 0012).

**As per claim 19:** some of the features of claim 19 are similar to the features of claims 15 and 17. Hence, the similar features of claim 19 are rejected on the same ground and motivation as claims 15 and 17. The difference, limitations of claim 19 are provided as shown below.

means for receiving the position information from the portable communications device reads on '391 (see col. 4, lines 16-65; col. 12, lines 17-59).

means for storing the position information as to the portable communications device reads on '391 (see col. 4, lines 41-49).

information processing means for performing the operation of storing the received position information in the storing means reads on '391 (see col. 12, lines 5-55). Collection includes storing.

storing means, for storing position information, during specified period of time before the reception of the command until the reception and transmitting the stored information during the specified period of time reads on '621 (see page 3, paragraphs 0020-0038).

**As per claim 21:** the features of claim 21 are similar to the features of claims 15 and 17. Hence, claim 21 is rejected on the ground and motivation of claims 15 and 17.

**As per claim 29:** the features of claim 29 are similar to the features of claims 15 and 17. Hence, the similar features of claim 29 are rejected on the same ground and motivation as claims 15 and 17.

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**As per claim 30:** most of the features of claim 30 are similar to the features of claim 15 and 17. Hence, the similar features of claim 30 are rejected on the same ground and motivations as claims 15 and 17. the difference, features are provided herein below.

means for storing the position information reads on '391 (see col. 4, lines 13-65; col. 12, lines 17-67);

information processing means for performing the operation of storing the measured position information in the storing means reads on '391 (see col. 4, lines 13-65; col. 12, lines 17-67).

**As per claim 31:** the feature of claim 31 is similar to the feature of claim 4. hence, claim 31 is rejected on the same ground and motivation as claim 4.

**As per claim 32:** the feature of claim 32 is similar to the feature of claim 15. hence, claim 32 is rejected on the same ground and motivation as claim 15. In that, one of ordinary skill in the art knows that a user can initiate or interrupt any application provided in his/her communication device.

**As per claim 2:** the features of claim 2 are similar to the features of claims 15 and 17. Hence, claim 2 is rejected on the same ground and motivation as claims 15 and 17.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-8, 15-27 and 29-32 have been considered but are moot in view of the new ground(s) of rejection.

***Allowable Subject Matter***

Claims 10-14 are allowed.

The following is an examiner's statement of reasons for allowance:

**As per claims 10-14:** the claims are directed to location based call privacy. The prior art of record does not teach or fairly suggest the techniques of user controlled location information provision, as recited in, particularly, claims 10 and 11.

Claims 9, 28 and 33 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meless N Zewdu whose telephone number is (571) 272-7873. The examiner can normally be reached on 8:30 am to 5:00 pm..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Meless zewdu

M. Z.

Examiner

05 May 2005.



**WILLIAM TROST**  
**SUPERVISORY PATENT EXAMINER**  
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